

REMARKS

Claims 48-73 are pending and at issue in this application. Of these, claims 48, 58, and 66 are independent.

Applicants respectfully traverse the rejection of claims 48, 58, and 66 as anticipated by U.K. Patent Application No. GB 2,262,642 ("Claypole") and claims 49-57, 59-65, and 67-73, depending respectfully therefrom, as obvious over Claypole in further view of any combination of U.S. Patent No. 6,050,895 ("Luciano"), U.S. Patent No. 6,379,250 ("Adamczyk"), and U.K. Patent Application No. GB 2,147,773 ("Dickinson").

Each of claims 48-73 recites a gaming apparatus for, or a gaming method of, determining whether there are at least three related symbols in display regions that are contiguous and allowing a player to operate a second input device to play a bonus game in a display region that displays the at least three related symbols if there are at least three related symbols in display regions that are contiguous. Claypole does not disclose allowing a player to operate a second input device to play a bonus game in a display region if there are at least three related symbols in display regions that are contiguous, and therefore, Claypole cannot anticipate claims 48, 58, or 66 or claims 48-57, 58-65, or 67-73, which depend from them, respectively.

While Claypole discloses a fruit machine having a trail system used to initiate a game feature, Claypole does not disclose allowing a player to play a bonus game if there are at least three related symbols in display regions that are contiguous. Instead, Claypole discloses triggering a game feature only after a certain pre-determined trail value has been reached. The trail value is based on an individual or a cumulative total of numbers appearing on a minority of the fruit symbols. Due to happenstance, the trail value may occasionally be associated with an arrangement of related symbols when numbers happen to be attached to such an arrangement of related symbols, but the trail value is ultimately determined by the numbers on the fruit symbols,

not the location of three related symbols in display regions that are contiguous. Claypole does not inherently disclose that an arrangement of related symbols will produce a triggering trail value, i.e., a combination of related symbols does not necessarily trigger a bonus feature. The device and method of the pending claims, on the other hand, recite allowing a player to play a bonus game if there are at least three related symbols in display regions that are contiguous. Thus, Claypole does not disclose allowing a player to play a secondary game if there are at least three related symbols in display regions that are contiguous, and therefore, Claypole cannot anticipate any of pending claims 48-73.

Furthermore, Claypole cannot render any of the claims obvious, because Claypole does not recognize the advantage of triggering the bonus game if there are at least three related symbols in display regions that are contiguous. In a game such as the bowling game described in the specification, winning combinations correspond to particular aspects of the secondary bonus game. For example, the alignment of three "Strike Bonus" symbols in a row may trigger a "strike bonus" event, as opposed to a "spare bonus" event triggered when three "Spare Bonus" symbols are aligned. (See specification paragraph 25).

The triggering mechanism of Claypole, on the other hand, is based on a trail value determined by accumulating a sufficient amount of fruit numbers, and does not allow an association between the related contiguous set of symbols and an aspect of the second bonus game. Moreover, the trail value trigger mechanism of Claypole provides an additional obstacle for players to overcome in order to play any feature game. Therefore, not only does Claypole not suggest triggering a bonus game if there are at least three related symbols in display regions that are contiguous, Claypole actually teaches away from such a trigger because using the triggering mechanism of Claypole would render the device and method of the pending claims inoperable.

It is clear that the prior art must make a suggestion of or provide an incentive for a claimed combination of elements to establish a prima facie case of obviousness. See, *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985). This principle holds true even if the applied art could be modified to produce the invention recited by the pending claims. See, *In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") Because Claypole does not disclose or suggest the desirability of allowing a player to operate a second input device to play a bonus game in a display region if there are at least three related symbols in display regions that are contiguous, and in fact teaches away from such a device or method, Claypole cannot render the pending claims obvious.

Applicants further traverse the rejection of any of pending claims 48-73 as obvious over Claypole in further view of any combination of Luciano, Adamczyk, and Dickinson.

Each of the pending claims recite a gaming apparatus or gaming method that allows a player to operate a second input device to play a bonus game in a display region if there are at least three related symbols in display regions that are contiguous. As mentioned above, Claypole does not disclose this element. None of Luciano, Adamczyk, and Dickinson disclose this element, and thus no combination of the cited prior art can contain this element. It follows, therefore, that no combination of Claypole, Luciano, Adamczyk, and Dickinson can render any of the pending claims obvious.

CONCLUSION


Applicants have now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons, Applicants respectfully request reconsideration and allowance of rejected claims 48-73.

If there are matters that can be discussed by telephone to further the prosecution of this application, Applicants respectfully request that the Examiner call their attorney at the number listed below.

Respectfully submitted,

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